

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Andi Vonlanthen Conf. No. : 3393
Appln. No. : 10/766,162
Filed : January 28, 2004
Title : BEHIND-THE-EAR HEARING AID AND SURFACE-MOUNTED
MODULE FOR THIS TYPE OF HEARING AID
TC/A.U. : 2646
Examiner : Huyen D. Le

Customer No. : 116
Docket No. : 31856US3

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicants request review of the final rejection in the above-identified application pursuant to 1296 Off. Gaz. Pat. Office 67 (July 12, 2005) and 1303 Off. Gaz. Pat. Office 21 (February 7, 2006).

No amendments are being filed with this request.

This request is being filed with a Notice of Appeal pursuant to 37 CFR § 41.31(a)(1), accompanied by the requisite fee of \$500.00 under 37 CFR § 41.20(b)(1).

The review is requested for the reasons stated on the following sheets.

The three-month period for responding to the Final Office Action expired on April 24, 2007. Accordingly, Applicants request and petition that the response date be extended for three months, up to and including, July 24, 2007. One month was previously paid for. Please charge the remaining \$900.00 extension of time fee to our Deposit Account No. 16-0820, Order No. 31856US3.

REASONS FOR REQUEST

1. Background

Claims 1, 3 and 10 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Examiner states that the claims contain “subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

2. Presence of Clearly Improper Rejection Based Upon Error in Facts

In the Office action dated January 24, 2007, the Examiner indicates that there is no reference in the original specification to “a plurality of modules being releasably mounted to said base part via a hinge part, one of said plurality of modules being a wireless signal transmission module and another one of said plurality of modules being a battery compartment module.” Applicant disagrees. On page 12, lines 2-4, the specification clearly teaches that *a plurality of extra modules can be stacked on a basic module*. Additional support for this feature is found on page 3, lines 21-24 of the specification. On page 12, lines 4-8, the specification clearly teaches that *the extra modules are releasably mounted*, i.e. by a snap-on part (43a) and a snapping part (46a) or by a bayonet lock. On page 11, lines 12-16, the specification clearly describes that the modules can be, *inter alia*, *wireless signal transmission modules* or *battery compartment modules*. Additional support for these features is found on page 5, lines 18-24. With reference to Figure 5, on page 11, lines 24-26, *a battery compartment (29a) is provided on each of the extra modules 51*. Thus, if two modules are stacked, one of which is a wireless signal transmission module, the second module would include a battery compartment as claimed.

In the Advisory action dated June 22, 2007, the Examiner states that “The specification does not teach an extra module (51) that can be stacked on another extra module (51) as shown in figure 9.” Applicant disagrees. As mentioned above, the specification clearly states that plural modules can be stacked. The term stacked would be clearly understood by one of ordinary skill in the art to mean that one extra module is stacked on another extra module. Further, since each extra module (51) has its own battery compartment (29a), as described on page 11, line 24 to page 12, line 2, one of ordinary skill in the art would readily appreciate that additional extra modules (51) would be stacked one behind the other (as implied on page 12, lines 2-4) by simply

inserting the plug-in part (34) of each additional extra module (51) into the battery compartment (29a) of the previous extra module (51). In further support of the fact that an additional extra module (51) could be attached to the battery compartment (29a) of a previous extra module (51) is that the battery compartment (29a) has substantially the same physical structure as the battery compartment (29), which is explicitly described as receiving the plug-in part (34) of the extra module (51). For example, it is described on page 11, lines 24-25, the compartment (29a) receives the same battery (33) that was taken out of the battery compartment (29). Also, as described on page 11, line 26 to page 12, line 2, the extra module (51) receives the cover (39) that was removed from the battery compartment (29). Thus, as illustrated by these examples, the physical structure of the extra module (51) and its battery compartment (29a) is substantially the same as the structure of the basic housing (3) and its battery compartment (29). Therefore, it logically follows that each extra module (51) would be capable of receiving the plug-in part (34) of an additional extra module (51), thereby permitting that “more than one surface-mounted module can be coupled modularly to the actual body of the device, in practice extending the hook-shaped body of the device.”

In conclusion, although the application as originally filed did not include a drawing figure illustrating a plurality of extra modules releasably mounted to a base part, as now claimed, it is clearly supported and described by the specification in a way that would convey to one of ordinary skill in the art that, at the time the application was filed, the inventor had possession of the claimed invention. Therefore, the requirements of 35 U.S.C. 112, first paragraph are clearly satisfied by the instant application.

3. Conclusion

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, Applicants request notification setting a date for filing an appeal brief.

If there are any additional fees resulting from this communication, please charge the same to our Deposit Account No. 16-0820, our Order No. 35511.

Respectfully submitted,
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July 10, 2007